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Attorney Docket: 622/40901CO
PATENT

OIPE JC34 JUN 16 2003 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	ROMAN SCHERTLER		
Serial No.:	08/962,776	Group Art Unit:	~~3206~~ 3716
Filed:	NOVEMBER 3, 1997	Examiner:	KHAN V. NGUYEN
Title:	A VACUUM PROCESS APPARATUS		

REQUEST FOR RECONSIDERATION

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JUN 23 2003
TECHNOLOGY CENTER R3700

Sir:

The following is responsive to the Office Action mailed on or about January 14, 2003.

The rejection of Claims 1-34 and 58-83 under 35 U.S.C.§ 251 as allegedly being an improper recapture of broadened claimed subject matter supposedly previously surrendered in obtaining the underlying patent is traversed.

Applicant notes that in this protracted proceeding in which the Patent and Trademark Office is supposed to take out of order, applicant had already surrendered its original Letters Patent as acknowledged in said Office Action. Under these circumstances, the Examiner should have been prepared to demonstrate a compelling case of recapture. Reconsideration of the rejection is requested on grounds that not even an arguable case has been demonstrated.

For example, the Office Action asserts that Claims 30-34, claims added in the reissue application, do not include the limitations of the "transport arm projecting from the axis/drive shaft in combination with arms operatively coupled to conveyors to move the conveyors [sic, move the conveyors] relative to the axis/drive shaft." Nowhere does the Office Action demonstrate where the quoted language was surrendered or, more precisely, where the original claims were amended to limit the scope of those claims such that the new reissue claims are broader.

We note that in none of the statements in the rejection has the Examiner explained how the scope of Claims 1, 8, 9, 16 and 30-34 as a whole has impermissibly broadened because of the absence of "projection from." As noted by the Federal Circuit's predecessor court in Patecell v. United States, 12 USPQ 2d 1440 (Ct. Cl. 1989) the crucial issue in assessing the significance of the amendment in the original claims is the applicant's intent. In this regard, the objective record evidence shows that applicant did not include the "projecting from" language from Claim 8, indeed the entirety of Claim 8, into Claim 1 in order to obtain allowance of Claim 1. Claims 8 had also been rejected as anticipated by a JP reference. In other words, Claim 1 was not allowed because of the addition of "projecting from." Claim 8 was incorporated into Claim 1 merely to provide antecedent basis for Claim 9 in which said arms (i.e., the arms of Claim 8) were defined as the driving means.

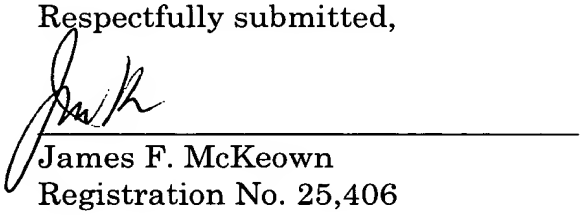
Accordingly, there has been no recapture. Early allowance of this case is now earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #622/40901CO).

Respectfully submitted,

June 16, 2003



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